

REMARKS

By this Office Action, the Examiner has required restriction to one of the following inventions under 35 U.S.C. §121:

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|-------------|---|
| Group I.    | Claims 1-22, 33, 36, 41-44, and 46, drawn to an ion channel modulator molecule, classification depends upon the structure of the molecule.  |
| Group II.   | Claims 23-26, drawn to an isolated nucleic acid molecule, a vector, and a host cell, and a method of making an ICMM, classified in class 536, subclass 23.5 and class 435, subclass 320.1, and 325.   |
| Group III.  | Claims 27-32 and 34, drawn to a method of isolating an ICMM, classified in class 530, subclass 412.   |
| Group IV.   | Claim 35, drawn to a method of isolating a gene encoding an ICMM, classified in class 435, subclass 5.  |
| Group V.    | Claims 37 and 38 (both in part), and 45, drawn to a method of treatment of a disease or condition comprising administering to a subject a pharmaceutical composition comprising an ICMM, classification depends upon the structure of the molecule. |
| Group VI.   | Claims 36-38 (all in part), drawn to a method of treatment of a disease or condition comprising administering to a subject a pharmaceutical composition comprising a nucleic acid encoding an ICMM, classified in class 514, subclass 44.           |
| Group VII.  | Claim 39 (in part), drawn to a process for the formulation of a composition comprising an ICMM, classification depends upon the structure of the molecule.  |
| Group VIII. | Claim 39 (in part), drawn to a process for the formulation of a composition comprising a nucleic acid encoding an ICMM, classified in class 514, subclass 44.   |
| Group IX.   | Claims 40 and 47, drawn to a method for studying the effect of ion channel modulation <i>in vitro</i> , classified in class 435, subclass 4.  |

Responsive to the Requirement for restriction, Applicants elect to prosecute the invention of Group I, with traverse, Claims 1-22, 33, 36, 41-44, and 46, which are drawn to an ion channel modulator molecule, classification depends upon the structure of the molecule.

Applicants respectfully request reconsideration of the Requirement for Restriction, or in the alternative, modification of the Restriction Requirement to allow prosecution of more than one group of Claims designated by the Examiner in the present Application, for the reasons provided as follows.

Under 35 U.S.C. §121 "two or more independent and distinct inventions ... in one Application may ... be restricted to one of the inventions." Inventions are "'independent'" if "there is no disclosed relationship between the two or more subjects disclosed" (MPEP 802.01). The term "'distinct'" means that "two or more subjects as disclosed are related ... but are capable of separate manufacture, use or sale as claimed, AND ARE PATENTABLE OVER EACH OTHER" (MPEP 802.01) (emphasis in original). However, even with patentably distinct inventions, restriction is not required unless one of the following reasons appear (MPEP 808.02):

1. Separate classification
2. Separate status in the art; or
3. Different field of search.

Further, under Patent Office Examining Procedures, "[i]f the Search and Examination of an entire Application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions" (MPEP 803, Rev. 8, May 1988) (emphasis added).

Applicants respectfully submit that the groups designated by the Examiner fail to define compositions and methods, with properties so distinct as to warrant separate Examination and Search. Claims 1-22, 33, 36, 41-44, and 46 of Group I, which are drawn to an ion channel modulator molecule, are fundamentally related to Claims 40 and 47 of Group IX, drawn to a method for studying the effect of ion channel modulation *in vitro*. The search for any of the methods separately classified by the Examiner as the invention of Group IX would require an additional search of the **identical** classes wherein the claims of Group I are classified, thus resulting in a duplicate search for the same material. Thus, Applicants submit that the Search and Examination of the entire Application, or, at least, of Group I with Group IX can be made without serious burden, and therefore the Examiner should examine all of the claims of the Application on the merits.

The Examiner's assertions to the contrary notwithstanding, Applicants respectfully submit that conjoint examination and inclusion of all of the Claims of the present Application would not present an undue burden on the Examiner, and accordingly, withdrawal of the Requirement for Restriction, or, at the least, modification to include the Claims drawn to Group I and Group IX is in order.

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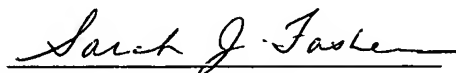
Attorney Docket No.: 2488-1-008

No additional fees are believed to be necessitated by the foregoing Response. However, should this be erroneous, authorization is hereby given to charge Deposit Account No. 11-1153 for any underpayment, or credit any overages.

In accordance with the Examiner's request, Applicants further elect the EV048 sequence shown in Figure 9a. Applicants believe that the election reads on all of the claims of Group I.

In view of the above, an early action on the merits of the Claims is courteously solicited.

Respectfully submitted,



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Enclosure: Petition for a One Month Extension of Time